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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,153	01/14/2004	Robert J. Vermillion	16990.3	3159

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EXAMINER

FORTUNA, JOSE A

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 08/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/757,153	Applicant(s) VERMILLION, ROBERT J.	
	Examiner José A. Fortuna	Art Unit 1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-21 and 49-51 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-21 and 49-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/10/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of group II, claims 9-21 and 49-51 in the reply filed on July 03, 2003 is acknowledged.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 9-12, 17-21, 49 and 51 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 14-18 of copending Application No. 10/997,544. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the claims overlaps. The scope of the current application is broader than claims 14-18 of the copending application and encompasses the composition of claims 14-18 of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Specification

3. The disclosure is objected to because of the following informalities: on paragraph [0026] the mentioned US Patent No. 4,000,790 does not correspond to its description, i.e., the mentioned patent is drawn to an hydraulic pump. Should it be US Patent No. 4,606,790 to Young et al.?

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 9-12, 17-21, 49 and 51 are rejected under 35 U.S.C. 102(a) as being anticipated by Vermillion, US Patent No. 5,637,377.

Vermillion teaches a corrugated contained including a middle wavelike layer **24**, sandwiched between two layers **28** and **30**, **see figures**. Vermillion teaches that the middle layer, the wavelike/corrugated layer contains no less than 7.5% of an electrical conductive substances and the layers sandwiching the electrical conductive layer contain static dissipative substances, see column 4, lines 16-54. Note that Vermillion teaches that the electric conductive substance is carbon particles, preferably carbon black particles, see column 4, lines 20-33 and that the medium is preferably made of Kraft pulp. Note

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that Vermillion teaches the same conductive and dissipative properties as claimed in claims 10-11, see for example see column 4, lines 16-54 and column 5, lines 51-57 and paragraph bridging columns 3-4. The amount of sulfur of claim 20 is taught in column 4, lines 16-54 and in example 1, column 7. The basis weight of the conductive paperboard is within the claimed range, see column 5, lines 31-41.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 9-12, 17-21 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by McAllister et al., US Patent No. 4,909,901.

McAllister et al. teach a multilayer fibrous material suitable for use as EMI and RFI shielding packaging material, see abstract. McAllister et al. teach that the fibrous material is composed of paper or paperboard first and second layers and an inner layer containing conductive carbon particles, see abstract. McAllister et al. teach that in order to render the outer layers antistatic or static dissipative, the layers are coated with a clay composition, i.e., uniformly distributed in the outer layers, column 2, lines 50-59. The conductivity of the dissipative layers and the conductive layer in the same claimed range is disclosed in column 3, lines 62-65.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 9-13, 16-21 and 49 rejected under 35 U.S.C. 102(b) as being anticipated by Berbeco, US Patent No. 4,455,350.

Berbeco teaches a static dissipating surface covering sheet comprising a middle layer having conductive properties and outer layer having dissipative properties. Berbeco teaches the use of ethylene glycol to provide static dissipative properties to desired layer,

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see abstract. Berbeco teaches the use of carbon particles, including carbon black, in the electrical conductive middle sheet, see column 3, lines 12-68 and paragraph bridging columns 4 and 5.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 13-16 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vermillion, US Patent No. 5,637,377 or McAllister et al., US Patent No. 4,909,901. in view of Yasuda, US Patent No. 3,682,696.

The primary references have been discussed above. However, they do not teach the use of the dissipative agents as claimed, i.e., DADMAC, PEG or diethanol amide. However, Yasuda teaches that the same substances can be used to electrification preventive substances, i.e., anti-static agents, and teaches that the substances can be either coated on the paper or added to the pulp, see column 1, lines 30-38 and column 1, 70 through column 2, line 59. Therefore, using the

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substances taught by Yasuda as the dissipative agents of the primary references would have been obvious to one of ordinary skill in the art, since he/she would have reasonable expectation of success if the compounds suggested by Yasuda were used for the intended purpose. Note also that the compounds of the primary references, Vermillion and McAllister et al., are functional equivalent to the compounds taught by Yasuda and it has been held that “[W]here two equivalents are interchangeable for their desired function, substitution would have been obvious and thus, express suggestion of desirability of the substitution of one for the other is unnecessary.” In re Fout 675 F. 2d 297, 213 USPQ 532 (CCPA 1982); In re Siebentritt, 372 F.2d 566, 152 USPQ 618 (CCPA 1967).

Conclusion


11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of “Fiberboard compositions.”

Any inquiry concerning this communication or earlier communications from the examiner should be directed to José A. Fortuna whose telephone number is 571-272-1188. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


José A Fortuna
Primary Examiner
Art Unit 1731

JAF